

REMARKS**Claim Status**

Claims 91-154 are pending in the application. Claims 91, 95, 99, 122, 127, 140, and 149 were previously amended. Claim 132 is being currently amended. Claims 1-90 were previously cancelled. Applicant respectfully requests reconsideration of the rejected claims in view of the arguments below.

Entry of Amendment

Entry of claim amendment is respectfully requested. The amendment should be entered because it adopts the Examiner's suggestion in the Final Office Action, and corrects a clerical error (improper dependency) in claim 132. *See* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) §714.13 (8th ed., rev. 1, Feb. 2003).

Allowed Claims

Applicant gratefully acknowledges the notification of allowance of claims 99-107, 122-135, and 149-153.

Art Rejections

The Final Office Action rejected claims 91-98, 111, 113-116, 121, 139, 141-144, and 154 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Number 5,327,534 to Hutchison *et al.*

("Hutchison" hereinafter); claims 108-110, 112, 117-120, 138, and 140-148 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hutchison in view of U.S. Patent Number 5,546,385 to Caspi *et al.* ("Caspi"). According to the summary of the Office Action, claims 136 and 137 were also rejected, but no reason was given. We respectfully request reconsideration of these rejections.

Regarding independent claims 91 and 95, the Final Office Action states that Hutchison discloses, at col. 9, lines 25-49, "a multiport LAN bridge incorporating the steps of capturing the address from the bus [and] converting the address into a value stored in the routing tag." The cited portion of Hutchison appears to teach implementation and operation of an alias comparator 246, which is also known as a source address (SA) comparator, to detect duplicate network addresses. It appears that the comparator 246 (1) compares the source address of a received frame to the addresses stored in the comparator's memory, and (2) if the comparator detects a match, then, under certain circumstances, a signal on line 270 is asserted to indicate that a duplicate alias address problem exists within the network.

The cited portion does not teach the step of converting the address into a value stored in a routing tag of a cell. Hutchison's signal on line 270 may carry information that has been derived from an address, but the signal on line 270 apparently does not get placed in a cell. In telecommunications, a cell generally means a packet. *See, e.g.*, COMPUTER DICTIONARY 91, (Microsoft, 5th ed., 2002). Moreover, it appears that Hutchison does not teach that the signal on line 270 is used for routing. As we have already mentioned in the previous paragraph, the signal on line 270 appears to indicate, when true, that a duplicate alias problem exists. Hutchison, col. 9, lines 49-50. To the undersigned it appears that the signal is not a routing tag of a cell.

Perhaps the rejection is premised on perceived functional equivalence of the signal on Hutchison's line 270 and the address-derived value stored in a routing tag of a cell, as recited in independent claims 91 and 95. The use of such perceived equivalence to reject the claims would be improper.

The basis of the rejection here is anticipation under section 102, not obviousness under section 103. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). (Both *Verdegaal Bros.* and *Richardson* cases are quoted in MPEP §2131.) Because anticipation requires the reference to teach every element "as set forth in the claim," equivalence, functional or otherwise, has no place under section 102.

Even under section 103 – which was not applied to claims 91 and 95 – functional equivalence is not synonymous with obviousness. "In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents." MPEP § 2144.06 (emphasis added) (citing *In re Ruff*, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). It is well settled that the standard applicable to an obviousness determination is whether the claimed matter would have been obvious to a person skilled in the art at the time of the invention. Existence of functional and mechanical equivalents simply does not force

the conclusion that the subject matter as a whole would have been obvious as a matter of law. *E.g.*, *In re Flint*, 330 F.2d 363, 367-68, 141 U.S.P.Q. 299 (C.C.P.A. 1964).

Moreover, we had amended claims 91 and 95, prior to the Final Office Action, to recite that the address converted into a routing tag of a cell is provided by a computer system bus. We have argued that Hutchison describes operation of a network, not of a computer system bus. The Final Office Action dismissed this argument: “Also, it is noted that the bus is interpreted as a connection or wire or cable which is taught by the Hutchison.” This is correct in that a bus can be implemented with a connection, wire, or cable. Here, however, the claims recite not merely a bus or a connection, but a computer system bus. One technical dictionary defines a system bus as follows:

The bus that connects the CPU to main memory on the motherboard. I/O buses, which connect the CPU with the systems other components, branch off of the system bus.

The system bus is also called the *frontside bus*, *memory bus*, *local bus*, or *host bus*.

Webopedia, available at www.webopedia.com. More broadly, a computer system bus is a bus connecting internal hardware components of a computer. In contrast, Hutchison describes a network bus. Both are buses, and both may include connections, but they are not identical. The claims in issue recite specific limitations – capturing and converting an address from a computer system bus. These limitations should be considered.

Without guidance, the word “bus” can be construed to cover both a computer system bus and a network bus. We have argued and still believe that the specification of the present application provides sufficient guidance to construe “bus” as a computer system bus, *i.e.*, as a conduit

connecting various functional units of a computer system, to allow information flow between or among the functional units. Whether the honorable Examiner accepts this argument should not matter at this point because we have amended claims 91 and 95, expressly adding the “computer system” qualifier to the word “bus.” This qualifier should not be ignored.

For all these reasons, we respectfully submit that independent claims 91 and 95 are patentable over Hutchison.

Several dependent claims were rejected under 35 U.S.C. §103 as unpatentable over Hutchison in view of Caspi. Regarding claims 110, 112, 117, 138, 140, and 145, the Final Office Action stated that the motivation to combine Hutchison with Caspi was “for connecting the users for communication.” Regarding claims 119, 120, 147, and 148, the Final Office Action stated that it would have been obvious to combine a sliding window technique with Hutchison “in order to control the flow of data.” Both of these purported suggestions are of the most general kind. Even if they provide guidance or motivation to combine, such guidance with respect to the particular form of the invention amounts to no more than “obvious to try” suggestion. It is insufficient to support an obviousness rejection. *In re Roemer*, 59 U.S.P.Q.2d 1527, 1531 (Fed. Cir. 2001).

Finality of the Action

Grounds for rejection should be fully and clearly stated, and statutory basis for any ground of rejection should be designated. MPEP §707.07(d). Here, claims 108, 109, and 118, have been

rejected under section 103, but neither the Final Office Action nor the previous Office Action explains how the cited references can be combined, and does not point out the incentive for the combination. In particular, neither Office Action explains where the teaching of the additional limitations of these dependant claims – self-configuring sAMCAM and incomplete transaction cache – can be found. We have previously traversed these rejections, but the Final Office Action still does not provide a clear statement as to why the rejections have been maintained. As regards claims 136 and 137, neither the Final Office Action nor the previous Office Action provides even a statutory basis for their rejection. Because reasons for rejection of at least some claims have not been given, the Applicant cannot “judge the propriety of continuing the prosecution” of these claims. 37 C.F.R. §1.104; MPEP §707; *see also* 35 U.S.C. §132(a) (“Whenever, on examination, any claim for a patent is rejected, . . . the Director shall notify the applicant thereof, stating the reasons for such rejection”).

For these reasons, we respectfully submit that final rejection was premature, and request its withdrawal.


CONCLUSION

For the foregoing reasons, Applicant respectfully submits that all pending claims are patentable over Hutchison and Caspi. To discuss any matter pertaining to the present application, the Examiner is invited to call the undersigned attorney at (858) 720-9431.

Having made an effort to bring the application in condition for allowance, a timely notice to this effect is earnestly solicited.

Respectfully submitted,

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